

receiving, via said communications network, commitments from the gift givers for monetary contributions toward the purchase of a gift selected from the display of gift ideas;

combining the commitments for monetary contributions and updating the display of the gift ideas to reflect the current commitments toward the selected gift;

739 automatically generating a purchase request for the selected gift if the total of the commitments is equal to or greater than a purchase price of the gift; and

attempting to satisfy the purchase request,

wherein the commitment of each giver that commits to make a monetary contribution is for any giver-desired portion of the uncommitted balance of the gift's purchase price.

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#### **REMARKS**

Reconsideration and allowance of the subject patent application are respectfully requested.

Claims 195-211 were rejected under 35 U.S.C. Section 112, second paragraph, as allegedly being indefinite. Claims 195 and 209 are amended to address the issue raised in the office action and withdrawal of the rejection of claims 195-211 under 35 U.S.C. Section 112, second paragraph, is respectfully requested.

Claims 199 and 200 have been written in self-standing independent form. These claims were not rejected based on prior art and, in view of the amendments to address the Section 112, second paragraph, rejection, are now believed to be allowable.

Claims 195, 196, 198, 201, 204-208 and 210-214 were rejected under 35 U.S.C. Section 102(e)<sup>1</sup> as allegedly being clearly anticipated by "UCOPIA: Ucopia Unveils New Wedding Registry Partners ..." (the "Ucopia document"). For a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art. See, *e.g.*, *Motorola, Inc. v. Interdigital Technology Corp.*, 43 USPQ2d 1481, 1490 (Fed. Cir. 1997). Even assuming (without admitting) that the Ucopia document is enabling for the system disclosed therein, the Ucopia document does not disclose each and every element of the claims rejected based thereon and therefore the Ucopia document cannot anticipate these claims.

The Ucopia system provides a "group purchase" feature in which

[c]ouples designate an item for group purchase on their registry form and specify the dollar amount of shares to be sold. Typically, a share is \$50. Individual guests can then purchase one or more shares. The gift remains on the couple's registry until it is fully purchased. If the full purchase price is not reached, the couple may either purchase the remaining shares or obtain a gift certificate to the retailer for the total amount of the shares already purchased. *Ucopia website, Frequently Asked Questions*

The "share" aspect of the Ucopia group purchase feature has undesirable consequences for both the gift recipient and the gift giver. At the time a gift is registered, the gift recipient must specify the dollar amount of shares to be sold. The specification of share price requires the gift recipient to perform an extra step, thereby increasing the time and effort expended to set up the registry. Moreover, retail prices are often of odd

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<sup>1</sup> Claims 195-211 are pending in this application. Accordingly, the reference to claims 212-214 in the statement of the rejection is incorrect. In addition, although claim 209 is discussed in the body of the rejection, it is not identified in the statement of the rejection. Further, Section 102(e) sets forth conditions under which certain patent applications constitute prior art. The Ucopia document is not a patent application and thus it may not be used in a Section 102(e) rejection. Should the Examiner continue to maintain that the Ucopia document anticipates any claimed subject matter, Applicant requests that each

amounts, for example, \$979.99 and are not readily divisible into shares. The gift recipient must therefore spend additional time calculating a share price at which these odd amounts can be divided into equal shares. Since the typical wedding registry may have 50 to 200 items, the additional steps of specifying a share price and the number of shares for each gift could be quite time consuming. In complete contrast to the system described in the Utopia document, the claimed method and system does not require the extra steps of setting a share price and a number of shares and thus is more convenient and less time consuming to use.

Furthermore, some gift prices may not be divisible into equal shares at all. If the gift price is equal to a prime number (*e.g.*, \$1,333.37), then it would be impossible to divide the price into equal shares. There are approximately 8,000 "prime number" price points under \$1,000.00 that cannot be split into equal shares. A similar problem arises if some default share price (*e.g.*, \$50.00) is used. A \$1,333.37 gift cannot be divided into a whole number of equal \$50.00 shares. Here again, in complete contrast to the system described in the Utopia document, the claimed method and system is readily usable for all price points.

Finally, gift recipients typically lack sufficient information to set an optimal share price since they have no idea as to what potential gift givers are willing or are able to spend. If the share price is set too high, too few gift givers will be able to afford the shares. If the share price is set too low, there may be an insufficient number of givers to purchase all of the shares.

At the time a gift is purchased, the gift giver in the system described in the Ucopia document must give at least one share. There is no provision in the Ucopia system for giving less than one share. For example, if the gift recipient has set the share price for a gift at \$50, the gift giver cannot contribute \$25 toward the purchase of that gift. The gift giver is also not allowed to contribute an amount that is between the cost of one and two shares. If the share price is \$50, it is not possible to contribute \$75. The end result is that in the first case, some givers may not be able to afford the share price and in the second case the gift giver contributes less than he or she might have.

Independent claim 195 and 209 are directed, among other things, to enabling a plurality of gift givers to each make a respective commitment for a monetary contribution of *any giver-desired amount* toward a gift for a gift recipient and to automatically generating a purchase request for the selected gift if the total of the commitments is equal to or greater than the gift's purchase price. The "partial purchase" feature is described, for example, on pages 24-26 of the subject application and permits a plurality of gift-givers to each make a contribution toward a gift. Significantly, in accordance with the claimed method and system, each gift giver can make a commitment for *any giver-desired amount* toward a gift. See, e.g., claim 195, ll. 18-20 ("...wherein the commitment of each giver that commits to make a monetary contribution is for *any giver-desired portion of the uncommitted balance* of the gift's purchase price").

The Ucopia document does not disclose (or even suggest) a method or system in which each giver can commit to make a monetary contribution for any giver-desired portion of the uncommitted balance of the gift's purchase price. In the Ucopia system, the commitment of each giver that commits toward the purchase of a gift is constrained

by the share price specified for that gift. Thus, a user may not contribute \$25 or \$75, for example, toward the purchase of a gift whose share price has been set to \$50. In complete contrast to the Ucopia system, the claimed method and system permit a gift giver to contribute as much or as little as he or she wants. This results in greater convenience for gift recipients, and maximizes the amount of gifts received. For example, a gift giver wishing to spend \$75 can spend exactly \$75.

For at least this reason, the Ucopia document cannot possibly anticipate the subject matter of claims 195 and 209 or the claims dependent therefrom.

It is alleged on page 5 of the office action that "[s]ince the share price can be varied without limit it is anticipated that each giver can commit any giver-desired portion of the uncommitted balance." There is no disclosure in the Ucopia document or the Ucopia website supporting this assertion. In the Ucopia system, the gift recipient sets the share price at the time the gift is registered and this share price imposes the constraints on the amount that a gift giver can contribute as discussed above. There is absolutely no disclosure of somehow varying the share price "without limit" so that each giver can commit any giver-desired portion of the uncommitted balance.

In connection with claims 196 and 211, the office action further asserts that "since each share represents an underlying predetermined fixed monetary amount, the giver may specify any amount of money appropriate to monetary value of a gift by specifying number of share that represent his/her desired contribution..." It is however not true that the Ucopia system permits a gift giver to specify any amount of money. For example, if the share price is \$50, it is not possible for the gift giver to contribute \$25, nor is it possible for the gift giver to contribute \$75. In addition, while a gift giver in the Ucopia

system may specify one share, two shares, etc., there is no disclosure or suggestion of the gift giver *directly* specifying his/her commitment as an amount of money. For this additional and independent reason, Applicant submits that the Ucopia document does not anticipate the subject matter of claim 196.

With respect to claims 204-206, Applicant traverses the assertion in the office action that the features such as a recipient-specified price and a recipient-specified vendor are “well-established business practices” that are “inherent” in the Ucopia document. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is *not sufficient* to establish inherency. See, *e.g.*, *Continental Can Co. v. Monsanto Co.*, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). There is no disclosure in the Ucopia document of the features of claims 204-206 and there is no evidence establishing that the Ucopia system must necessarily possess these features. For example, there is no disclosure of recipient-determined prices or vendors for gift ideas as specified in claims 205 and 206, respectively. In addition, while the Ucopia system provides that incomplete purchases can be given to the registrant in gift certificates, there is no disclosure of providing the commitments for monetary contributions to the gift recipient as cash if the total of the commitments is less than the gift's purchase price as specified in claim 204. Unlike cash, gift certificates generally (1) can only be used in certain stores; (2) have expiration dates; and (3) are generally non-transferable. Moreover, gift certificates are backed only by the credit of each respective store.

Claims 197, 202 and 203 were rejected under 35 U.S.C. Section 103(a) as allegedly being obvious over the Ucopia document in view of the

“Weddingchannel.com” document. The weddingchannel.com document is applied as teaching a registry in which web pages are generated and supplied to gift givers.

However, the weddingchannel.com document does not remedy the above-noted deficiencies of the Ucopia document in connection with claim 195 (from which claims 197, 202 and 203 depend). As such, even assuming for the sake of argument that the combination of these documents would have been proper and that the combination were made, the subject matter of claims 197, 202 and 203 would not result.

In addition, claim 202 calls for receiving commitments from the gift givers that include commitments which are contingent upon other gift givers making commitments such that the total of all commitments is equal to or greater than the price of the selected gift. This feature is not disclosed or even remotely contemplated in the Ucopia document or the weddingchannel.com document. The office action takes official notice that

...specifying substitute gift item (for example as an item of second choice) and providing cash in lieu of gift item if the gift item is unavailable or cannot be collectively purchased is old and well-known business practice.

However, the feature of a gift giver making a commitment contingent upon commitments of others as set forth in claim 202 is not a gift substitution feature.


With respect to claim 203, Applicant believes that the general business practice with respect to out-of-stock or otherwise unavailable gifts was to cancel the order and issue a refund to the gift giver. The result of this practice is that the gift giver must select and purchase another gift. As set forth in claim 203, the claimed method permits the gift recipient to specify a substitution option for the gift idea. Prior to the present invention, "gift substitution" typically occurred when a recipient decided after receiving a gift that he/she did not want the gift or had received a duplicate gift from a different source. To

return the unwanted gift the gift recipient had to either return to the store or ship the gift back to the store, which is costly. The method of claim 203 allows the gift recipient to specify a substitution option for cash or for a different gift before a gift is shipped, or even before it is "given" by the gift giver and therefore avoid the cost of having to return to the store or to ship the gift back to the store. Applicant submits that this is not a well-known business practice. Applicant requests that the Examiner provide a reference showing the gift-substitution option of claim 203 should any rejection of this claim be maintained.

Applicant submits that the pending claims are in condition for allowance, and action to that end is earnestly solicited.

Respectfully submitted,

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**Version Marked to Show Changes Made**

**IN THE CLAIMS**

Claims 195, 199, 200 and 209 have been amended as follows:

195. (Amended) A method for enabling a plurality of gift givers to each make a respective commitment for a monetary contribution of any giver-desired amount toward a gift for a gift recipient, the method comprising:

receiving at a centralized gift registry computer system gift ideas supplied by the gift recipient;

storing the gift ideas in a memory which is part of, or accessible to, said gift registry computer system;

providing to the gift givers, based on the stored gift ideas and in response to requests supplied to said gift registry computer, an on-line display of the gift ideas;

receiving at said gift registry computer system commitments from the gift givers for monetary contributions toward the purchase of a gift selected from the on-line display of gift ideas;

combining the commitments for monetary contributions and updating the display of the gift ideas to reflect the current commitments toward the selected gift;

automatically generating a purchase request for the selected gift if the total of the commitments is equal to or greater than a [the gift's] purchase price of the gift; and

attempting to satisfy the purchase request,

wherein the commitment of each giver that commits to make a monetary contribution is for any giver-desired portion of the uncommitted balance of the gift's purchase price.

199. (Amended) A [The] method for enabling a plurality of gift givers to each make a respective commitment for a monetary contribution of any giver-desired amount toward a gift for a gift recipient [according to claim 195], the method comprising:

receiving at a centralized gift registry computer system gift ideas supplied by the gift recipient;

storing the gift ideas in a memory which is part of, or accessible to, said gift registry computer system;

providing to the gift givers, based on the stored gift ideas and in response to requests supplied to said gift registry computer, an on-line display of the gift ideas;

receiving at said gift registry computer system commitments from the gift givers for monetary contributions toward the purchase of a gift selected from the on-line display of gift ideas;

combining the commitments for monetary contributions and updating the display of the gift ideas to reflect the current commitments toward the selected gift;

automatically generating a purchase request for the selected gift if the total of the commitments is equal to or greater than a purchase price of the gift; and

attempting to satisfy the purchase request,

wherein the commitment of each giver that commits to make a monetary contribution is for any giver-desired portion of the uncommitted balance of the gift's purchase price, and

wherein attempting to satisfy the purchase request comprises:  
sending an offer to purchase the selected gift to a plurality of vendors;  
receiving an acceptance of the offer from one of the vendors; and  
requesting that the accepting vendor send the selected gift to the gift recipient.

200. (Amended) A [The] method for enabling a plurality of gift givers to each make a respective commitment for a monetary contribution of any giver-desired amount toward a gift for a gift recipient [according to claim 195], the method comprising:

receiving at a centralized gift registry computer system gift ideas supplied by the gift recipient;

storing the gift ideas in a memory which is part of, or accessible to, said gift registry computer system;

providing to the gift givers, based on the stored gift ideas and in response to requests supplied to said gift registry computer, an on-line display of the gift ideas;

receiving at said gift registry computer system commitments from the gift givers for monetary contributions toward the purchase of a gift selected from the on-line display of gift ideas;

combining the commitments for monetary contributions and updating the display of the gift ideas to reflect the current commitments toward the selected gift;

automatically generating a purchase request for the selected gift if the total of the commitments is equal to or greater than a purchase price of the gift; and

attempting to satisfy the purchase request,

wherein the commitment of each giver that commits to make a monetary contribution is for any giver-desired portion of the uncommitted balance of the gift's purchase price, and

wherein attempting to satisfy the purchase request comprises:

adding the purchase request for the selected gift to a gift list of gifts to be purchased;

aggregating purchase requests for identical gifts into a single purchase order;

sending an offer to purchase the gifts in the purchase order to a plurality of vendors;

receiving an acceptance of the offer from one of the vendors; and

requesting that the accepting vendor send the gifts in the purchase order to the appropriate gift recipients.

209. (Amended) A gift registry computer system configured to enable a plurality of gift givers to each make a respective monetary contribution of any giver-desired amount toward a gift for a gift recipient, the computer system comprising:

a communications circuit for connecting to a communications network;

a processor; and

a memory containing instructions executable by said processor to perform the steps of:

receiving gift ideas supplied by the gift recipient via said communications network;

storing the gift ideas in said memory or in another memory accessible to said gift registry computer system;

providing to the gift givers, based on the stored gift ideas and in response to requests supplied via said communications network, an on-line display of the gift ideas;

receiving, via said communications network, commitments from the gift givers for monetary contributions toward the purchase of a gift selected from the display of gift ideas;

combining the commitments for monetary contributions and updating the display of the gift ideas to reflect the current commitments toward the selected gift;

automatically generating a purchase request for the selected gift if the total of the commitments is equal to or greater than a [the gift's] purchase price of the gift; and

attempting to satisfy the purchase request,

wherein the commitment of each giver that commits to make a monetary contribution is for any giver-desired portion of the uncommitted balance of the gift's purchase price.